

ESTTA Tracking number: **ESTTA591301**

Filing date: **03/07/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Dental Imaging Technologies Corporation		
Entity	Corporation	Citizenship	Delaware
Address	1910 North Penn Road Hatfield, PA 19440 UNITED STATES		

Attorney information	Nicole K. McLaughlin Duane Morris LLP 30 S. 17th Street Philadelphia, PA 19103 UNITED STATES nkmclaughlin@duanemorris.com Phone:215 979 1191
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### Applicant Information

Application No	79129120	Publication date	02/11/2014
Opposition Filing Date	03/07/2014	Opposition Period Ends	03/13/2014
Applicant	HICAT GmbH Brunnenallee 6 Bonn, DEX 53177 DEX		

### Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Scientific or electrical measuring, signaling and controlling apparatus and instruments for imaging methods and techniques in the field of medical technology, namely, computer hardware for imaging in the medical, dental, and veterinary fields; apparatus for reproduction of images in the field of medical technology, namely, data processors, optical sensors, radiosensitive sensors, electromechanical sensors, electrical and optical detectors, wireless transmitters and receivers, film cameras, scanners, computer monitors, computers and printers; software for supporting surgical, medical and dental diagnosis, planning and therapy, in relation to imaging methods and techniques, namely, computer software for processing, displaying, retrieving, managing, storing, and transmitting radiographic images and data for use in the medical, dental, and veterinary fields and software for managing medical or dental practices, and for clinical and diagnostic applications and software for imaging in the medical, dental, and veterinary fields, none of the aforesaid goods being endoscopic instruments for diagnostic, monitoring and surgical purposes

Class 010. First Use: 0 First Use In Commerce: 0


All goods and services in the class are opposed, namely: Instruments and apparatus for supporting medical, dental, and surgical planning and therapy, namely, surgical instruments and apparatus for medical and dental use; Instruments and apparatus for supporting medical, dental, and surgical planning and therapy, namely, orthodontic splints and orthoses, namely, orthotics for the mouth and teeth for treating snoring and sleeping disorders, none of the aforesaid goods being endoscopic

instruments for diagnostic and surgical purposes
Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Training in the field of software that are used for supporting surgical, medical and dental diagnosis, planning and therapy, in relation to imaging procedures and technique
Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Scientific and industrial research in the field of medical technology in connection with imaging methods and techniques; computer programming for Electronic Data Processing (EDP) in relation to imaging methods and techniques in the field of medical technology; development of computer programs for supporting surgical, medical and dental diagnosis, planning and therapy, in relation to imaging methods and techniques; computer software consultancy
Class 045. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Licensing of computer software

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3169125	Application Date	11/14/2003
Registration Date	11/07/2006	Foreign Priority Date	NONE
Word Mark	I-CAT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 010. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00 Medical radiographic imaging equipment		

U.S. Registration No.	4296216	Application Date	08/03/2011
Registration Date	02/26/2013	Foreign Priority Date	NONE
Word Mark	I-CAT PRECISE		

Design Mark	<b>I-CAT PRECISE</b>
Description of Mark	NONE
Goods/Services	Class 010. First use: First Use: 2011/08/18 First Use In Commerce: 2011/08/18 3D Cone Beam Computed Tomography DentalImaging Device

Attachments	76562441#TMSN.gif( bytes ) 85388690#TMSN.jpeg( bytes ) HICATOpp.pdf(797019 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/NKM/
Name	Nicole K. McLaughlin
Date	03/07/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of the Application Serial No. 79/129,120  
Published in the *Official Gazette* on February 11, 2014

Mark: HICAT

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DENTAL IMAGING TECHNOLOGIES  
CORPORATION

Opposer,

v.

HICAT GmbH

Applicant.  
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**NOTICE OF  
OPPOSITION**

Opposer, Dental Imaging Technologies Corporation, a Delaware corporation, having a principal place of business at 1910 North Penn Road, Hatfield, Pennsylvania 19440 (hereinafter referred to as "Opposer"), believes that it will be damaged by registration of the trademark HICAT in International Classes 9, 10, 41, 42 and 45 as shown in Application Serial No. 79/129,120, for the goods and services set forth therein, and hereby opposes the same.

As grounds for the opposition, Opposer, through its counsel, alleges that:

1. Opposer, and its predecessors in interest, have been engaged in the manufacture and sale of advanced dental/medical and maxillofacial imaging products since at least as early as 1992.
2. Opposer offers radiographic imaging as well as cone beam imaging.
3. Opposer's imaging equipment allows clinicians access to 2D and 3D treatment tools for implants and restorations, oral and maxillofacial surgery, orthodontics, TMJ, airways and sinuses.

4. Opposer offers its dental/medical imaging equipment under the brand name I-CAT®. Opposer has been offering this imaging equipment under the I-CAT trademark since at least as early as January 2004.

5. Since January 2004, Opposer has launched additional imaging products sold under the I-CAT® brand, such as, I-CAT® NEXT GENERATION; I-CAT PRECISE® and I-CAT® FLX.

6. Opposer is the owner of U.S. Registration No. 3,169,125 for the mark I-CAT (the “I-CAT® Mark”) in Class 10 for “medical radiographic imaging equipment” and U.S. Registration No. 4,296,216 for the mark I-CAT PRECISE (the “I-CAT PRECISE® Mark”) in Class 10 for “3D cone beam computed tomography dental imaging device” (collectively herein referred to as “Opposer’s Marks”). Copies of the ownership and status information obtained from the U.S. Patent and Trademark Office database are attached herein and incorporated by reference into this pleading.

7. United States Trademark Registration No. 3,169,125 is valid, subsisting and incontestable. Pursuant to § 33 of the Lanham Act, 15 U.S.C. § 1115(b), Opposer’s United States Trademark Registration No. 3,169,125 serves as conclusive evidence of the validity of: (1) Opposer’s registered I-CAT® Mark; (2) the registration for the I-CAT® Mark; (3) Opposer’s ownership of the I-CAT® Mark; and (4) Opposer’s exclusive right to use the registered I-CAT® Mark in commerce on or in connection with medical radiographic imaging equipment—i.e. the goods specified in the registration.

8. United States Trademark Registration No. 4,296,216 is valid and subsisting. Pursuant to § 33 of the Lanham Act, 15 U.S.C. § 1115(a), Opposer’s United States Trademark Registration No. 4,296,216 serves as prima facie evidence of the validity of: (1) Opposer’s

registered I-CAT PRECISE® Mark; (2) the registration for the I-CAT PRECISE® Mark; (3) Opposer's ownership of the I-CAT PRECISE® Mark; and (4) Opposer's exclusive right to use the registered I-CAT PRECISE® Mark in commerce on or in connection with cone beam computed tomography dental imaging devices—i.e. the goods specified in the registration.

9. Opposer has used the well-known and distinctive I-CAT® Mark continuously in interstate commerce in the United States since at least as early as January 2004 and the well-known and distinctive I-CAT PRECISE® Mark since at least as early as August 2011.

10. Opposer offers and sells its medical/dental imaging equipment in connection with Opposer's Marks in all channels of trade customary for such goods in the United States.

11. Opposer's I-CAT®, I-CAT PRECISE®, I-CAT® NEXT GENERATION and I-CAT® FLX products are available and provided to consumers throughout the United States and the world.

12. Because of Opposer's extensive use of the I-CAT® Mark and the I-CAT PRECISE® Mark, Opposer's Marks have acquired enormous value and have become extremely well-known to the consuming public as identifying and distinguishing Opposer's products from those of its competitors.

13. On or about November 27, 2012, Hicat GmbH (hereinafter referred to as "Applicant") filed Application Serial No. 79/129,120 (the "Application"), to register the mark HICAT for the goods and services identified in Application Serial No. 79/129,120 in International Classes 9, 10, 41, 42 and 45 (the "HICAT Mark").

14. Applicant filed its Application based on Section 66A of the Lanham Act.

15. Upon information and belief, Applicant has not made any commercial use of the HICAT Mark to date.

16. Opposer's rights in the I-CAT® Mark and the I-CAT PRECISE® Mark predate any date on which Applicant can rely for purposes of priority for the HICAT Mark.

17. Applicant's HICAT Mark is confusingly similar in appearance, sound and commercial impression to Opposer's I-CAT® Mark and I-CAT PRECISE® Mark.

18. The goods and services identified in Application Serial No. 79/129,120 are identical and/or closely related to the goods which are offered and sold by Opposer under Opposer's I-CAT® Mark and I-CAT PRECISE® Mark and shown in Opposer's registrations for those marks.

19. The Application for registration and use by Applicant of a mark that is confusingly similar in appearance, sound and commercial impression to Opposer's I-CAT® Mark and I-CAT PRECISE® Mark, on or in connection with goods or services which are identical and/or closely related to the goods offered by Opposer under Opposer's I-CAT® Mark and I-CAT PRECISE® Mark, is likely to cause confusion and/or to cause mistake, or to deceive the trade and the general public into believing that Applicant's goods or services come from the same source as products bearing or sold in connection with Opposer's I-CAT Mark® or I-CAT PRECISE® Mark, and/or are otherwise authorized, sponsored or licensed by Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). As a result, the granting of the registration applied for will cause substantial damage and injury to Opposer.

20. By reason of the foregoing, Opposer will be damaged by the registration of the mark shown in Application Serial No. 79/129,120.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that Application Serial No. 79/129,120 for registration of the HICAT Mark be denied.

This Notice of Opposition is submitted via ESTTA.

Respectfully submitted,

DUANE MORRIS LLP

By: /NKM/  
Nicole K. McLaughlin

Dated: March 7, 2014

Attorney for Opposer  
30 S. 17<sup>th</sup> Street  
Philadelphia, PA 19103  
nkmclaughlin@duanemorris.com

**CERTIFICATE OF SERVICE**

I hereby certify that on March 7, 2014, the foregoing Notice of Opposition is being deposited with the United States Postal Service, with sufficient postage as first class mail in an envelope addressed to attorney of record for Applicant:

Jeffrey A. Smith  
Millen, White, Zelano, & Branigan, P.C.  
2200 Clarendon Blvd., Suite 1400,  
Arlington Courthouse Plaza I  
Arlington, VA 22201

/Nicole K. McLaughlin/



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Mark: I-CAT

I - CAT

US Serial Number: 76562441      Application Filing Date: Nov. 14, 2003  
US Registration Number: 3169125      Registration Date: Nov. 07, 2006  
Register: Principal  
Mark Type: Trademark  
Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.  
Status Date: Sep. 10, 2012  
Publication Date: Nov. 01, 2005      Notice of Allowance Date: Jan. 24, 2006

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### Mark Information

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Mark Literal Elements: I-CAT  
Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.  
Mark Drawing Type: 4 - STANDARD CHARACTER MARK

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### Related Properties Information

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International Registration Number: 0949030  
International Application(s) /Registration(s) Based on this Property: A0010625/0949030

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### Goods and Services

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Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks "\*" identify additional (new) wording in the goods/services.

For: Medical radiographic imaging equipment

International Class(es): 010 - Primary Class

U.S Class(es): 026, 039, 044

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 2004

Use in Commerce: Jan. 2004

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### Basis Information (Case Level)

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Filed Use: No	Currently Use: Yes	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

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### Current Owner(s) Information

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Owner Name: DENTAL IMAGING TECHNOLOGIES CORPORATION  
Owner Address: 1910 NORTH PENN ROAD  
HATFIELD, PENNSYLVANIA 19440  
UNITED STATES  
Legal Entity Type: CORPORATION      State or Country Where Organized: DELAWARE

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### Attorney/Correspondence Information

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**Attorney of Record****Attorney Name:** Ronald E. Shapiro**Docket Number:** CPA10480**Attorney Primary Email** [rshapiro@sasiplaw.com](mailto:rshapiro@sasiplaw.com)**Attorney Email** Yes**Address:****Authorized:****Correspondent****Correspondent** Ronald E. Shapiro**Name/Address:** Shapiro and Silverstein PLLC  
11350 Random Hills Road, Suite 740  
Fairfax, VIRGINIA 22030  
UNITED STATES**Phone:** 703-273-7680**Fax:** 703-273-7684**Correspondent e-mail:** [rshapiro@sasiplaw.com](mailto:rshapiro@sasiplaw.com)**Correspondent e-mail** Yes**Authorized:****Domestic Representative - Not Found****Prosecution History**

<b>Date</b>	<b>Description</b>	<b>Proceeding Number</b>
Sep. 10, 2012	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Sep. 10, 2012	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	71378
Sep. 10, 2012	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	71378
Aug. 16, 2012	TEAS SECTION 8 & 15 RECEIVED	
May 30, 2012	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Mar. 21, 2012	ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY	
Sep. 06, 2007	ATTORNEY REVOKED AND/OR APPOINTED	
Sep. 06, 2007	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Jan. 24, 2007	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Nov. 07, 2006	REGISTERED-PRINCIPAL REGISTER	
Oct. 02, 2006	LAW OFFICE REGISTRATION REVIEW COMPLETED	70997
Sep. 22, 2006	ASSIGNED TO LIE	70997
Sep. 15, 2006	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Aug. 14, 2006	STATEMENT OF USE PROCESSING COMPLETE	65362
Jul. 17, 2006	USE AMENDMENT FILED	65362
Jul. 17, 2006	TEAS STATEMENT OF USE RECEIVED	
Jan. 24, 2006	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Nov. 01, 2005	PUBLISHED FOR OPPOSITION	
Oct. 12, 2005	NOTICE OF PUBLICATION	
Sep. 08, 2005	LAW OFFICE PUBLICATION REVIEW COMPLETED	70997
Sep. 02, 2005	ASSIGNED TO LIE	70997
Sep. 01, 2005	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 12, 2005	TEAS/EMAIL CORRESPONDENCE ENTERED	70629
Aug. 03, 2005	CORRESPONDENCE RECEIVED IN LAW OFFICE	70629
Aug. 03, 2005	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jul. 26, 2005	NON-FINAL ACTION MAILED	
Jul. 26, 2005	NON-FINAL ACTION WRITTEN	76840
Jul. 15, 2005	TEAS/EMAIL CORRESPONDENCE ENTERED	76538
Jul. 08, 2005	CORRESPONDENCE RECEIVED IN LAW OFFICE	76538
Jul. 08, 2005	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jun. 29, 2005	NON-FINAL ACTION MAILED	
Jun. 29, 2005	NON-FINAL ACTION WRITTEN	76840
Jun. 28, 2005	LIE CHECKED SUSP - TO ATTY FOR ACTION	70997
Dec. 28, 2004	LETTER OF SUSPENSION MAILED	

Dec. 27, 2004	SUSPENSION LETTER WRITTEN	76840
Dec. 09, 2004	AMENDMENT FROM APPLICANT ENTERED	70629
Nov. 26, 2004	CORRESPONDENCE RECEIVED IN LAW OFFICE	70629
Nov. 26, 2004	PAPER RECEIVED	
May 28, 2004	NON-FINAL ACTION MAILED	
May 27, 2004	ASSIGNED TO EXAMINER	76840
Dec. 19, 2003	NEW APPLICATION ENTERED IN TRAM	

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### **Maintenance Filings or Post Registration Information**

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**Affidavit of Continued Use:** Section 8 - Accepted

**Affidavit of Incontestability:** Section 15 - Accepted

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### **TM Staff and Location Information**

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**TM Staff Information - None**

**File Location**

**Current Location:** TMO LAW OFFICE 111

**Date in Location:** Sep. 10, 2012

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Mark: I-CAT PRECISE

I-CAT PRECISE

US Serial Number: 85388690  
US Registration Number: 4296216  
Register: Principal  
Mark Type: Trademark  
Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.  
Status Date: Feb. 26, 2013  
Publication Date: Aug. 07, 2012  
Application Filing Date: Aug. 03, 2011  
Registration Date: Feb. 26, 2013  
Notice of Allowance Date: Oct. 02, 2012

## Mark Information

Mark Literal Elements: I-CAT PRECISE  
Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.  
Mark Drawing Type: 4 - STANDARD CHARACTER MARK

## Related Properties Information

Claimed Ownership of US 3169125  
Registrations:

## Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks \*...\* identify additional (new) wording in the goods/services.

For: 3D Cone Beam Computed Tomography Dental Imaging Device

International Class(es): 010 - Primary Class

U.S Class(es): 026, 039, 044

Class Status: ACTIVE

Basis: 1(a)

First Use: Aug. 18, 2011

Use in Commerce: Aug. 18, 2011

## Basis Information (Case Level)

Filed Use: No	Currently Use: Yes	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

## Current Owner(s) Information

Owner Name: DENTAL IMAGING TECHNOLOGIES CORPORATION  
Owner Address: 1910 NORTH PENN ROAD  
HATFIELD, PENNSYLVANIA 19440  
UNITED STATES  
Legal Entity Type: CORPORATION  
State or Country Where Organized: DELAWARE

## Attorney/Correspondence Information

Attorney of Record  
Attorney Name: Nicole K. McLaughlin  
Attorney Primary Email: [nkmcLaughlin@duanemorris.com](mailto:nkmcLaughlin@duanemorris.com)  
Attorney Email: No

Address:

Authorized:

Correspondent

Correspondent Name/Address: Nicole K. McLaughlin  
Duane Morris LLP  
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Philadelphia, PENNSYLVANIA 19103  
UNITED STATES

Phone: 215-979-1191

Fax: 215-689-4934

Correspondent e-mail: [nkmclaughlin@duanemorris.com](mailto:nkmclaughlin@duanemorris.com)

Correspondent e-mail Yes  
Authorized:

Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Feb. 26, 2013	REGISTERED-PRINCIPAL REGISTER	
Feb. 04, 2013	ATTORNEY REVOKED AND/OR APPOINTED	
Feb. 04, 2013	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Jan. 25, 2013	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Jan. 24, 2013	LAW OFFICE REGISTRATION REVIEW COMPLETED	70884
Jan. 24, 2013	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Jan. 17, 2013	STATEMENT OF USE PROCESSING COMPLETE	71034
Dec. 19, 2012	USE AMENDMENT FILED	71034
Jan. 15, 2013	CASE ASSIGNED TO INTENT TO USE PARALEGAL	71034
Dec. 19, 2012	TEAS STATEMENT OF USE RECEIVED	
Oct. 02, 2012	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Aug. 07, 2012	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Aug. 07, 2012	PUBLISHED FOR OPPOSITION	
Jul. 18, 2012	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jul. 02, 2012	LAW OFFICE PUBLICATION REVIEW COMPLETED	70884
Jun. 28, 2012	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jun. 06, 2012	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Jun. 05, 2012	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Jun. 05, 2012	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
May 30, 2012	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Mar. 21, 2012	ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY	
Mar. 03, 2012	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 03, 2012	NON-FINAL ACTION E-MAILED	6325
Mar. 03, 2012	NON-FINAL ACTION WRITTEN	78426
Feb. 09, 2012	TEAS/EMAIL CORRESPONDENCE ENTERED	70884
Feb. 09, 2012	CORRESPONDENCE RECEIVED IN LAW OFFICE	70884
Feb. 03, 2012	ASSIGNED TO LIE	70884
Jan. 24, 2012	TEAS VOLUNTARY AMENDMENT RECEIVED	
Jan. 05, 2012	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Dec. 05, 2011	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Dec. 05, 2011	NON-FINAL ACTION E-MAILED	6325
Dec. 05, 2011	NON-FINAL ACTION WRITTEN	78426
Nov. 28, 2011	ASSIGNED TO EXAMINER	78426
Aug. 08, 2011	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Aug. 06, 2011	NEW APPLICATION ENTERED IN TRAM	

## TM Staff and Location Information

TM Staff Information - None

**File Location**

**Current Location:** PUBLICATION AND ISSUE SECTION

**Date in Location:** Jan. 24, 2013